

Remarks

Claims 1-27 were previously pending in the subject application. Claims 1-15 and 19-27 have been withdrawn pursuant to a Restriction Requirement. Claim 16 is amended above to clarify that the temporary visual indicator is visible in the composition. Claims 17 and 18 are also amended above to correct inadvertent typographical errors. No new matter is introduced by these amendments, and the scope of the claims is unaffected. Upon entry of these amendments, claims 16-18 will remain before the Examiner.

Claims 16-18 have been rejected under 35 U.S.C. §102(b) as being anticipated by Garner *et al.* (U.S. Patent No. 5,429,952). Applicant respectfully traverses, because the cited reference does not teach each and every element of the claimed invention.

Garner *et al.* teach the use of a low molecular weight hapten to be used as a marker to establish identity and source of a product. Garner *et al.* mention erythrosine as one possible substance that may be used as such a marker. However, Garner *et al.* make it very clear that any marker used needs to be of such a low concentration as to not be visible. In fact, at column 3, lines 17-23, Garner *et al.* explicitly state "The invention provides a method of labeling a product in such a way that the presence of the marker substance . . . could not be routinely determined by a counterfeiter or other person unfamiliar with the marker." (emphasis added). Thus, Garner *et al.* teach that the marker, such as erythrosine, should not be detectable at all, including visually, to anyone who does not know the identity of the marker. The claimed invention, on the other hand, requires that the temporary visual indicator be initially visible in the composition. From the common meaning of the terms, as well as from the subject specification (page 7, lines 26-28), it is clear that the visual indicator must be visible for a period of time once the user applies the composition to a surface. There simply is no disclosure in Garner *et al.* of any composition containing a visible indicator.

The Office Action states that the erythrosine-containing composition taught by Garner *et al.* must have all the same properties as the claimed composition because it is the same chemical composition (bottom of page 3 – top of page 4). Applicant respectfully disagrees, because temporary visibility is not a property that is inherent to a chemical. Rather, whether a substance is detectable to a human eye is dependent on other factors, including the amount and

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concentration of that substance, as well as what other substances are present. In the case of the Garner markers, the concentrations taught are so low, as necessitated by the purpose of the composition, that they are not visually detectable. Applicant also disagrees with the assertion that the claim limitation of "initially visible" is an intended future use. To the contrary, it is an explicit characteristic of the marker element in the claimed composition. Garner *et al.* teach no such element.

It is well established that in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). As discussed above, Garner *et al.* do not teach a composition that comprises erythrosine as a temporary visual indicator in sufficient amount to be initially visible in the composition. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

Claims 16-18 have been rejected under 35 U.S.C. §103(a) as obvious over Garner *et al.* (U.S. Patent No. 5,429,952). Applicant respectfully traverses.

It has been well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield Applicant's invention does not make the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125,1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art ..." *In re Dow Chemical Co.* 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). An assertion of obviousness without the required suggestion or expectation of success in the prior art is tantamount to using Applicant's disclosure to reconstruct the prior art to arrive at the subject invention. Hindsight reconstruction of the prior art cannot support a §103 rejection, as was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969).

As discussed above, Garner *et al.* explicitly teach that a marker should not be visually detectable to anyone who does not know the identity of the marker. This way, a counterfeiter cannot see the marker and include it in a fake product. Thus, it is necessary to the purpose of

Garner *et al.* that the marker not be visually detectable, since counterfeiters could simply include the marker if it was. A skilled artisan would have found no motivation to modify the Garner formulations to make the erythrosine marker visible at all, even temporarily. Doing so would destroy the purpose of the Garner formulations. The law is clear that such modifications cannot support an obviousness rejection. See *In re Gordon, supra*.

The Examiner contends that initial visibility and capability of becoming substantially invisible after application are inherent physiochemical properties of erythrosine. However, as discussed above, visibility is not an inherent property of a chemical. Garner *et al.* teach that the erythrosine should be added in extremely low concentrations of 1 ppb to 25 ppm so as to not be visually detectable (column 5, lines 47-56). The subject invention, on the other hand, requires that the erythrosine be initially visible in the claimed composition.

The Office Action goes on to state that Garner *et al.* teach that erythrosine can be present at different concentrations (see last paragraph, page 6). However, the cited portion of the Garner reference discloses that a marker can be employed in different concentrations in different batches of products to be identified (see column, lines 40-52). The different concentrations in different batches must still be low enough to not be visually detectable, since the purpose of the markers in such varying batches is to prevent counterfeiting. It is clear that Garner *et al.* are teaching that concentrations of marker high enough to be visually detectable cannot be used. Such concentrations would defeat the purpose of the compositions taught by Garner *et al.*, since a counterfeiter could then see the marker and include it in counterfeit versions.

"A prima facie case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). Applicant directs the Examiner to column 9, lines 49-59, of the Garner *et al.* specification. Garner *et al.* teach that the marker is present "in such low concentrations in the labeled chemical or composition, its presence... is not immediately apparent to someone who is unaware of the addition." (emphasis added). It is indisputable that

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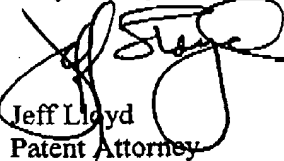
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Garner *et al.* are teaching the erythrosine to not be visible in the product. Therefore, Garner *et al.* clearly teach away from the claimed invention. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a).

In view of the foregoing remarks, Applicant believes that all pending claims are in condition for allowance, and such action is respectfully requested.

Applicant also invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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